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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,018	09/20/2001	Joseph E. Kaminkow	0112300-581	2458

29159 7590 09/11/2007  
BELL, BOYD & LLOYD LLP  
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CHICAGO, IL 60690

EXAMINER
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MCCULLOCH JR, WILLIAM H

ART UNIT	PAPER NUMBER
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3714

NOTIFICATION DATE	DELIVERY MODE
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09/11/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

**Office Action Summary**

Application No.

09/957,018

Applicant(s)

KAMINKOW, JOSEPH E.

Examiner

William H. McCulloch Jr.

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-12 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12 and 14-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/25/2007.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This action is in response to remarks received 4/25/2007. Applicant's arguments relating to U.S. 6,102,798 with respect to the rejection(s) of claims 1-4, 6-7, 9-12, 14, 21-22 and 25 under 35 USC § 102(e) and claims 8, 15-20, and 23-24 under 35 USC § 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) with mailroom date 4/25/2007 was filed in compliance with the provisions of 37 CFR 1.97-1.98. Accordingly, the examiner has considered the information disclosure statement.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4, 6-12, and 14-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 10/327538. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed toward substantially similar subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-4, 6-12, and 14-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,511,375. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed toward substantially similar subject matter.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, 6, 9-12, 14, 21-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/09259 to Bennett (hereinafter Bennett).

The examiner notes that the independent claims presented have substantial (but not total) overlap in scope. The examiner has perceived the differences in the scope of the independent claims. However, in the interest of conciseness, the examiner will address the most specific elements of the independent claims. All broader limitations are addressed because they are within the scope of the below-described elements and the teachings of Bennett. Regarding claims 1, 6, 9, 14, 21, and 25, Bennett teaches the following limitations:

- A gaming device (figs. 1,6), the gaming device comprising:
- A display device (display 11);
- An input device (touch sensitive areas on the display surface, see at least the abstract)
- A processor in communication with the display device and the input device (e.g., game control processor circuits, see at least the abstract; microprocessor, see at least p.3, ll. 11-15), wherein the processor is programmed to:
  - Cause a plurality of masked selections to be displayed to a player by the display device (see at least figs. 2-4; p.3, ll. 25-28; and p.4, ll. 9-12);
  - Associate a plurality of different values with the masked selections prior to said masked selections being picked by the player and without displaying which values are associated with which selections (see at least figs. 2-4 and p.3, ll. 11-31);

- Enable the player to pick a plurality of said masked selections for a designated number of sets, said designated number being at least two (the examiner interprets a “set” as a plurality of selections chosen by the player; see at least figs. 2-4 and p.3, ll. 11-31);
- Form the designated number of sets of a plurality of said values, each set determined by the player picking a plurality of said selections for said set wherein the plurality of values in each set are based on the values associated with the selections picked by the player for said set (see at least figs. 2-4 and p.3, ll. 11-31);
- Cause a display of each of the sets and the values in each set (see at least figs. 2-4);
- Generate a plurality of awards by selecting a plurality of but not all of the values in each one of said sets (selections bearing a prize are selected (e.g. 5 credits), whereas “zero prize” zones are not used to generate the award(s); see at least p.2, ll. 17-19);
- Generate a resulting award by performing at least one mathematical operation on the awards generated from the set (adding the prize bearing selections and/or multiplying them by a bet of credits; see at least figs. 2-4 and p.3, line 32-p.4, line 19);
- Provide said resulting award to the player (see at least p.4, ll. 13-19).

Claims 3-4, and 11-12 are explained above with regard to the independent claims. Regarding claims 2, 10, 22, and 24, Bennett teaches selecting at least the largest value or award of each set (see at least p.3, line 32-p.4, line 19).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8, 15-20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied above in view of U.S. 6,345,824 to Selitzky.

Regarding claims, 8, 15-16, 18-19, and 23 Bennett teaches the invention substantially as described above. Bennett lacks in explicitly teaching selecting "at least one but not all of" the awards from the plurality of different sets in order to generate a resulting award. Selitzky teaches a game with a bonus feature wherein if the player's hand includes more than one bonus combination, only the highest ranking bonus combination is rewarded (see at least 7:1-13). It would have been obvious to one of ordinary skill in the art at the time of invention to apply the teaching of Selitzky (only awarding the highest ranking bonus combination) to the invention of Bennett in order to allow more award bearing selections (in Bennett) to be displayed on the screen without the provision of large awards paid by the gaming establishment, resulting in more frequent but smaller value awards being paid out by the gaming machine. Such a result is favorable to a gaming establishment because it allows customers to be frequently

awarded (which results in more repeat customers) without the need for the gaming establishment to pay large sums.

Bennett describes claims 17, 20, and 24, as shown with regard to claims 2, 10, 22, and 24 above. Bennett describes claim 19 with respect to claims 1, 6, 9, 14, 21, and 25 above.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied above, and further in view of Official Notice.

Regarding claim 7, Bennett lacks in explicitly teaching that the display device displays the selections and reveals values associated with the selections that are not picked by the player. The Examiner takes official notice that it was notoriously well known in the art at the time of invention to display the non-chosen values, in addition to the chosen values. One of ordinary skill in the art at the time of invention would have been motivated to do so in order to indicate to the player what he or she could have selected. U.S. 6,102,798 to Bennett (previously of record) shows this feature to be well known in the art.

### ***Response to Arguments***

11. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.




If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William H. McCulloch Jr.  
Examiner  
Art Unit 3714  
9/3/2007

wm



Robert E. Pezzuto  
Supervisory Patent Examiner  
Art Unit 3714